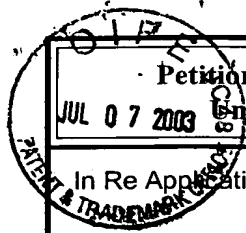


DAC #26



**Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b) (Large Entity)**

Docket No.  
5468-07-LAV

RECEIVED  
JUL 08 2003

In Re Application Of: Shirley Barcelon et al.

OFFICE OF PETITIONS

Serial No.	Filing Date	Examiner	Group Art Unit
09/092,696	June 5, 1998	Leslie A. Wong	1761

Invention:

**ENHANCED FLAVORING COMPOSITIONS CONTAINING N-ETHYL-P-MENTHANE-3-CARBOXAMIDE AND METHOD OF MAKING AND USING THE SAME**

Attention: Office of Petitions  
COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper response to a notice or action by the Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus any extension of time actually obtained.

**APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION**

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee--required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. ☒ A proposed reply to the above-identified notice or action:

☒ is enclosed. ☐ was filed on \_\_\_\_\_

The proposed reply is in the form of: Response

2. ☐ The issue fee:

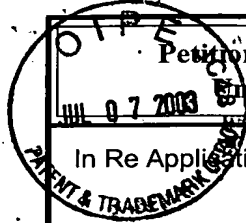
☐ is enclosed. ☐ was paid on \_\_\_\_\_

3. ☒ The abandoned application was a:

☐ design application. ☒ utility application. ☐ plant application.

4. ☐ A terminal disclaimer (and fee) disclaiming a period equivalent to the period of abandonment is enclosed.

5. ☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.



**Petition For Revival Of An Application For Patent Abandoned  
Intentionally Under 37 CFR 1.137(b) (Large Entity)**

Docket No.

5468-07-LAV

**RECEIVED**

**JUL 08 2003**

In Re Application Of: Shirley Barcelon et al.

**OFFICE OF PETITIONS**

Serial No.	Filing Date	Examiner	Group Art Unit
09/092,696	June 5, 1998	Leslie A. Wong	1761

Invention:

**ENHANCED FLAVORING COMPOSITIONS CONTAINING N-ETHYL-P-MENTHANE-3-CARBOXAMIDE AND  
METHOD OF MAKING AND USING THE SAME**

**Calculation and Payment of Fees**

Enclosed are the following fees:

- |   |                             |
|---|-----------------------------|
| 6. <input checked="" type="checkbox"/> Petition fee under 37 CFR 1.17(m) in the amount of:          | <u>\$1,300.00</u>           |
| 7. <input type="checkbox"/> Fee for amendment in the amount of:                                     | <u>                    </u> |
| 8. <input type="checkbox"/> Fee for extension of time to respond to Office Action in the amount of: | <u>                    </u> |
| 9. <input type="checkbox"/> Issue fee in the amount of:   | <u>                    </u> |
| 10. <input type="checkbox"/> Continuing application filing fee in the amount of:                    | <u>                    </u> |
| 11. <input type="checkbox"/> Terminal disclaimer fee in the amount of:                              | <u>                    </u> |
| 12. <input type="checkbox"/> _____  | <u>                    </u> |
| Total fees enclosed: <u>\$1,300.00</u>  |                             |

The fee of **\$1,300** is to be paid as follows:

- ☒ A check in the amount of the fee is enclosed.
- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. **23-0510**

**Petition For Revival Of An Application For Patent Abandoned  
Unintentionally Under 37 CFR 1.137(b) (Large Entity)**

Docket No.  
5468-07-LAV

In Re Application Of: Shirley Barcelon et al.

Serial No.  
09/092,696

Filing Date  
June 5, 1998

Examiner  
Leslie A. Wong

Group Art Unit  
1761

Invention:

**ENHANCED FLAVORING COMPOSITIONS CONTAINING N-ETHYL-P-MENTHANE-3-CARBOXAMIDE AND  
METHOD OF MAKING AND USING THE SAME**

**Statement**

The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

*Signature*

Dated: July 3, 2003

Allen R. Kipnes, Esq.  
Registration No. 28,433

WATOV & KIPNES, P.C.  
P.O. Box 247  
Princeton Junction, New Jersey 08550  
(609) 243-0330  
(609) 275-1010 - Facsimile

I certify that this document and fee is being deposited  
on July 3, 2003 with the U.S. Postal Service as  
first class mail under 37 C.F.R. 1.8 and is addressed to the  
Mail Stop Petition, Commissioner for Patents, P.O. Box  
1450, Alexandria, VA 22313-1450.

*Signature of Person Mailing Correspondence*

Jill S. Garretson

*Typed or Printed Name of Person Mailing Correspondence*

CC:



#27  
RECEIVED  
JUL 08 2003

ARK:jsg070303\1901041.RES

OFFICE OF PETITIONS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Applicant : Shirley Barcelon et al.  
Serial No. : 09/092,696  
Filed : June 5, 1998  
For : ENHANCED FLAVORING  
COMPOSITIONS CONTAINING N-ETHYL-  
P-MENTHANE-3-CARBOXAMIDE AND  
METHOD OF MAKING AND USING THE  
SAME  
Examiner : Leslie A. Wong  
Art Unit : 1761  
Attorney Docket No. : 5468-07-LAV

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VIRGINIA 22313-1450	
ON	July 3, 2003
NAME	Jill S. Garretson
SIGNATURE	<i>Jill S. Garretson</i>

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

July 3, 2003

RESPONSE

Dear Sir:

This is in response to the Office Action of November 18, 2002. All of the claims of the application (claims 9, 11, 13, 14, 16 and 18) stand rejected under 35 USC Section 112 on the ground that Applicant does not teach what is encompassed

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by "consisting essentially of" with respect to the claimed invention. The rejection is hereby traversed and reconsideration is respectfully requested.

The term "consisting essentially of" has been used to define the flavoring composition. The phrase "consisting essentially of" means that the composition includes the specific ingredients defined in the claims (one or more flavoring agents selected from the group of flavoring agents) and the particular amount of N-ethyl-P-menthane-3-carboxamide. The phrase does not exclude the addition of another ingredient which does not materially affect the characteristics of the invention. The Board of Technologies Corp. v. Kalco, Ltd. 7 USPQ 2d 1097 (Fed. Cir. 1988), Cer. Denied, 488 U.S. 968 (1988).

The characteristics of the claimed invention are as described below. The present invention concerns confectionery compositions in chewing gums which contain a flavor effecting amount of an enhanced flavoring composition as described in claim 1. As indicated in the present application, N-ethyl-P-menthane-3-carboxamide is used as a flavor modifier to enhance the flavor of the flavoring agent. This synergistic effect is found when the compound is used at low levels in combination with the flavoring agent to provide a sharper or brighter flavor which is more defined and longer-lasting when compared with compositions containing the same flavoring agent without N-ethyl-P-menthane-3-carboxamide. Thus, the term "consisting essentially of" can include other ingredients which do not materially effect the ability of the N-ethyl-P-menthane-3-carboxamide to enhance the flavoring agent as described above. It is therefore submitted that the claims of the application meet

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all of the requirements of 35 USC Section 112 and withdrawal of the rejection is therefore deemed proper and is respectfully requested.

Claims 14 and 18 stand rejected as obvious over Record (U.S. Patent No. 5,372,824). Furthermore, all of the claims of the application stand rejected as obvious over Cherukuri (U.S. Patent No. 5,009,893). The rejections are hereby traversed and reconsideration is respectfully requested.

Applicants' claimed invention concerns confectionery and chewing gum compositions which contain a flavoring effective amount of an enhanced flavoring composition. The enhanced flavoring composition includes at least one of a select group of flavoring agents (absent mint flavors) and also includes an amount of N-ethyl-P-menthane-3-carboxamide effective to enhance the flavoring agent wherein the latter compound is present in an amount of from about 0.04 to 2.2% by weight of the enhanced flavoring composition. For confectionery compositions, the enhanced flavoring composition is present in an amount of from about 0.10% to 1.0% by weight and for chewing gums the enhanced flavoring composition is present in the amount of 0.8% to 3.5% by weight of the chewing gum.

N-ethyl-P-menthane-3-carboxamide is a known cooling agent. It is often used in compositions with menthol, also a known cooling agent, to enhance the cooling and negate the bitterness of menthol. Menthol is also used in products having mint flavor as it comprises approximately 50% of peppermint oil and is present whenever peppermint oil is used.

U.S. Patent No. 5,372,824 teaches mint-flavored chewing gums having reduced bitterness. Bitterness from the menthol in mint-flavor gums will occur in the latter part of chewing when the sweeteners have dissipated. The reduced bitterness is achieved by reducing the amount of 1-menthol in the peppermint oil used as the mint flavoring agent. An embodiment of the reference discloses the addition of cooling agents to the 1-menthol reduced flavoring agent in order to add back some of the cooling effect lost with the 1-menthol reduction. The reference clearly teaches only mint-flavored products and therefore inherently only teaches peppermint oil. There is no teaching or suggestion regarding non-mint flavoring agents nor that such non-mint flavoring agents can be similarly treated with those requiring mint flavor and the problems associated with the presence of 1-menthol.

The amounts of the cooling agents used in the reference relative to the menthol flavor are distinctly higher than taught and claimed by Applicants. Applicants' claim a product wherein the enhanced flavorant has N-ethyl-P-menthane-3-carboxamide present in an amount which is from 0.04% to 2.2% by weight of the flavor used. The reference teaches the use of N-ethyl-P-menthane-3-carboxamide in two examples, Flavor No. 2 and Example 3A. In these Examples, N-ethyl-P-menthane-3-carboxamide is present in amounts of 3.32% and 2.35%, respectively of the total mint flavor. If one compares the presence of N-ethyl-P-menthane-3-carboxamide to the eucalyptus oil flavorant also used in the mint flavor being illustrated in the examples, the N-ethyl-P-menthane-3-carboxamide is 94.6% and 91% of the combination, respectively. This amount of N-ethyl-P-menthane-3-

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carboxamide as a cooling agent when combined with menthol does not at all suggest the claimed gum products wherein N-ethyl-P-menthane-3-carboxamide is present in an amount of 0.04% to 2.2% for enhancement of the specific non-mint flavor.

U.S. Patent No. 5,372,824 cannot therefore be held to teach or suggest Applicants' claims. The claims of the present application require a non-mint flavorant, a particular ratio of flavorant to N-ethyl-P-menthane-3-carboxamide, and an amount of the enhanced flavorant in the claimed product. There is no teaching or suggestion of a useful product containing other than a mint flavorant. The only non-mint example, cherry, would lead away from combining N-ethyl-P-menthane-3-carboxamide with the flavorant. It is therefore submitted that claim 14 and 18 are neither taught nor suggested by U.S. Patent No. 5,372,824 and withdrawal of the rejection is deemed proper and is respectfully requested.

Cherukuri (U.S. Patent No. 5,009,893) teaches the combination of menthol and carboxamides to be utilized as cooling agents. This reference along with the prior reference concerns the known use of carboxamides as cooling agents. The preferred ratio is from about 5% to about 70% by weight menthol and about 30% to about 95% by weight of N-ethyl-P-menthane-3-carboxamide in the combination. The goal of the Cherukuri reference as with the prior reference is to reduce the bitterness associated with the use of menthol as a cooling agent in mint flavored compositions. While Cherukuri does not state that the invention is only concerned with the mint flavors it is clear that Cherukuri addresses a problem associated with mint flavors. This is because menthol provides a bitterness together with a cooling effect and



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approximately 50% of natural peppermint oil is menthol. No other flavoring agents are taught by Cherukuri.

The only example which contains a flavor agent absent menthol is a comparative example. This example (Example 3, Table V at number 3) combines N-ethyl-P-menthane-3-carboxamide with a cherry flavor in a candy composition. The amount of the combined flavorants is 1.9% of the candy composition. No cooling effect was found in the cherry flavored candy absent the presence of menthol. In the Example V, number 4, which combines menthol with the cherry, the amount of flavorant used in a candy increases to 2.4% of the candy composition. This amount of flavorant differs significantly from, and does not suggest the amount used by Applicants' in their claimed confectionery composition wherein the enhanced flavorant is found effective in an amount of from about 0.1% to 1.0% by weight of the confectionery composition.

Concerning chewing gum, Cherukuri does not provide any teaching of a flavored product having other than a mint flavor. Those chewing gums taught by Cherukuri contain at least 4% of N-ethyl-P-menthane-3-carboxamide based on the flavoring composition. Applicants' claimed invention limits the maximum amount of N-ethyl-P-menthane-3-carboxamide to only about 2.2% by weight of the enhanced flavoring composition.

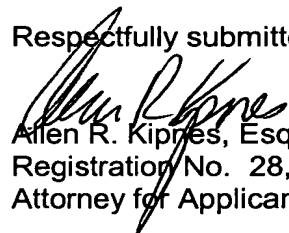
It is therefore submitted that Cherukuri does not teach or suggest Applicants' claims. Applicants' claims require a non-mint flavorant, a particular ratio of flavorant

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to N-ethyl-P-menthane-3-carboxamide, and an amount of that enhanced flavorant in the claimed product. There is simply no disclosure in Cherukuri to teach or suggest what is present in Applicants' claims. In view of the foregoing, Applicants' submit that the present application is in condition for allowance and early passage to issue is therefore deemed proper and is respectfully requested.

It is believed that no fee is due in connection with this response. However, if any fee is due, it should be charged to Deposit Account No. 23-0510.

Respectfully submitted,

  
Allen R. Kipnes, Esquire  
Registration No. 28,433  
Attorney for Applicant

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